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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,487	06/10/1999	MITCHEL KRISS	29284/35302	8147
34431 7590 07/18/2008 HANLEY, FLIGHT & ZIMMERMAN, LLC 150 S. WACKER DRIVE SUITE 2100 CHICAGO, IL 60606				
EXAMINER				
NORMAN, MARC E				
ART UNIT		PAPER NUMBER		
3744				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/329,487

Applicant(s)

KRISS ET AL.

Examiner

Dr. Marc E. Norman

Art Unit

3744

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 54-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 30, 31, 39-43 and 48-53 is/are rejected.
- 7) ☒ Claim(s) 5-29, 32-38 and 44-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 4/9/08 have been fully considered but they are not persuasive. Applicant has amended independent claims 1, 30, 39, and 43 to be directed to data associated with a preferred customer program. However, an archive internet search shows that applicant was engaged in panelist data related to preferred customers ("attracting the type of customers retailers want" (Internet Archive, page 4, second bulleted question)) more than a year before the filing of the present application. The purchase estimation recited in the claims is broadly applicable across different customer types. It is considered obvious that a company would of course be interested in the purchasing behavior of its preferred customers and, as shown in Applicant's archived web site, Applicant was advertising the use of panelist data to attract desirable (i.e., preferred) customers. As such, it is a matter involving simple predictable results to one of ordinary skill in the art to apply the panelist/surveying teachings of Klepacki and Yamamoto et al. to a company's preferred customers for the purpose of understanding their particular purchasing behavior.

Election/Restrictions

Newly submitted claims 54-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they recite subject matter related to a preferred customer identification card. Such subject matter requires a substantively different search that was conducted for the previously presented claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 30, 31, 39-43, and 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klepacki in view of Yamamoto et al., and further in view of Internet Archives.

As per claims 1, 30, 39, and 43, Klepacki teaches reading panelist data (TEXT, line 9), regarding purchase from a supplier of interest (TEXT, lines 6-8) and from other suppliers (TEXT, lines 9-10, 25, 41-43), and determining general relationships therebetween (other retailer

shares of product sales (TEXT, line 25) is a share (i.e., a percentage of a total), and thus is related to the share of product sales of the supplier of interest). Klepacki does not discuss using a relationship between the two sets of customer purchase data in conjunction with reading overall customer data regarding purchases from the supplier of interest to estimate the purchases made by the overall customers from the other suppliers.

As indicated in the Klepacki reference, it is in a supplier's interest to know what their customers are buying from their competitors (TEXT, lines 9-10, 25, 41-43). Further, there are whole fields of market research dedicated to both understanding/modeling customer behavior (see discussion within Klepacki regarding product mix (TEXT, lines 28-38) and customer loyalty (TEXT, lines 44-49); see also as a general reference on this topic "The where's and why's behind home and personal care purchases..." Drug Store News, 1998) and to understanding competitor sales. Klepacki teaches using panelist surveys to collect all of the required data for Applicant's claimed invention. The market forces are clearly established that a supplier is interested in both the purchasing trends of their customers and the sales trends of their competitors. Understanding both, and especially their customer's activities with their competitors, provides a clear, obvious, and predictable business advantage in terms of developing market-based business decisions. To the extent that the data is made available (as is the case from the panelist data in the Klepacki reference), it is an obvious and predictable next step to one of ordinary skill in the art to use that data to see what a supplier's customers are buying from its competitors.

Further, as previously discussed, this is simply a matter of linearly scaling up the data to the overall customer population. It is generally well known to take a sample and generalize,

infer or extrapolate the response from the sample to the population as a whole. As has been discussed previously, Yamamoto teaches the basic concept of determining the purchases made by an overall customer population by scaling up data regarding purchases from a surveyed sample shop (value in parentheses at column 8, line 18) using a relationship between panelist data and overall customer data (ratio at column 8, lines 21-29). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply such scaling up of the data collected by Klepacki for the purpose understanding the purchasing trends of the overall customer base. Motivation for applying such scaling up to the Klepacki reference comes from the fact that it is well known that businesses monitor their product mix and try to get their customers to buy more when they are in the store vs. what they buy from competitors (again, see discussion within Klepacki regarding product mix (TEXT, lines 28-38) and customer loyalty (TEXT, lines 44-49); see also again as a general reference on this topic "The where's and why's behind home and personal care purchases..." Drug Store News, 1998).

It is clearly in a business's interest to know what its customers are purchasing from its competitors. Given the data collected by Klepacki, such determination is a simple and obvious calculation using well-established basic scaling techniques to achieve a predictable result to one of ordinary skill in the art within the context of the well established market forces that businesses are interested in collecting information about both customer behavior and competitor sales and activities.

Further, while neither Klepacki nor Yamamoto et al. are specifically directed to data associated with preferred customers, an internet archive search shows that applicant was engaged in panelist data related to preferred customers ("attracting the type of customers retailers want"

(Internet Archive, page 4, second bulleted question) more than a year before the filing of the present application. The purchase estimation recited in the claims is broadly applicable across different customer types. It is considered obvious that a company would of course be interested in the purchasing behavior of its preferred customers and, as shown in Applicant's archived web site, Applicant was advertising the use of panelist data to analyze and attract desirable (i.e., preferred) customers. As such, it is a matter involving simple predictable results to one of ordinary skill in the art to apply the panelist/surveying teachings of Klepacki and Yamamoto et al. to a company's preferred customers for the purpose of understanding their particular purchasing behavior.

As per claims 2, 31 and 50-53, Klepacki further teaches aggregating data according to category (e.g., types of products).

As per claim 3, Klepacki teaches the collected data being in terms of dollars spent.

As per claim 4, Klepacki teaches determining the share for the supplier and for competitors (TEXT, line 25).

As per claims 40-42, 48, and 49, these claims are rejected for similar reasons as have already been addressed above regarding claims 1, 30, 39, and 43.

Reminder of 37 C.F.R. 1.105 Requirement

Applicant is also once again reminded of the requirement under 37 C.F.R. 1.105 that was sent to Applicant in the earlier Office Action of 11 September 2002. Based on the teachings of Klepacki, it appears that the Assignee of this case was at least active in collecting panelist data regarding purchases of a supplier's customers from its competitors a full five years before the

present Application was filed. It further appears that Applicant was conducting panelist data related to “the type of shoppers retailers want” (i.e., preferred customers). Applicant is again reminded of the requirement to disclose any related or pertinent products or services provided by Applicant in the marketplace prior to the filing date of this application.

Allowable Subject Matter

Claims 5-29, 32-38, and 44-47 are objected to as being dependent upon a rejected base claim, but would be allowable, for the reasons already set forth in previous Office Actions, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Marc E. Norman whose telephone number is 571-272-4812. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN
/Dr. Marc E. Norman/
Primary Examiner, Art Unit 3744